

REMARKS

The Examiner has made a restriction requirement under 35 U.S.C. § 121 between the inventions of:

Group I. Claims 1-48, 53, and 54, drawn to a method of performing primer extension reactions, classified in class 702, subclass 019;

Group II. Claim 49, drawn to a composition comprising a primer having a region capable of hybridizing to target nucleic acids, classified in Class 536, subclass 24.33;

Group III. Claims 51-52, drawn to a method of monitoring the efficiency of incorporation of chain terminators into a primer extension reaction, classified in Class 435, subclass 006;

Group IV. Claims 55-59, drawn to a method of screening animals for susceptibility to a disease or disorder, classified in Class 435, subclass 006; and

Group V. Claims 60-61, drawn to a method of breeding scrapie-resistant sheep comprising: determining the identity of polymorphic nucleotides, classified in Class 800, subclass 008.

In response, Applicants provisionally elect with traverse Group III, claims 51 and 52, but expressly reserve the right to pursue the non-elected embodiments at a later time or in one or more divisional applications and/or continuation applications.

Applicants assume that claim 50, which is not put in any group, was intended to be part of Group II. The Examiner is respectfully asked to confirm that claim 50 is intended to be part of Group II.

The Examiner's alleged basis for the restriction between the inventions is that the claims in Groups I-V are patentably distinct and require separate searches, which would cause an undue burden on the U.S. Patent Office to search more than one class. Applicants respectfully disagree, and submit that the Examiner has not met the burden of establishing: i) two or more independent and distinct inventions claimed in one application under 35 U.S.C. § 121, and ii) the search would be an undue burden on the U.S. Patent Office.

The Examiner presents only general assertions that the claims are different with respect to limits, method steps, and endpoints. Applicants submit that the claims are linked by the

common conceptual scheme of conducting primer extension, yet the Examiner groups the claims into five groups and the distinction between Groups I-V is unclear and the Examiner has not established that the inventions in Groups I-V are independent and distinct and would require separate searches.

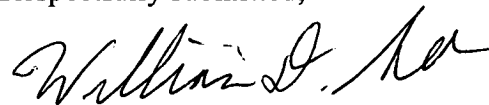
For example, Group I (claims 1-48, 53, and 54) include primer extension, Group V claims 60 and 61 also all include primer extension and specifically recite the methods of claim 1 and 22, respectively. Yet claims 60 and 61 are put into a completely different group – Group V, and not Group I. Thus the distinction between groups is unclear.

Moreover, the Examiner would almost certainly cite the same reference in one group against the other groups. Applicants submit that separate searches for each of the alleged groups would be substantially duplicative, and the Examiner has not demonstrated that a search directed to one group is unreasonable or would present an undue burden on the U.S. Patent Office. Accordingly, Applicants respectfully request the restriction requirement to be withdrawn.

No fee is believed to be due with respect to the filing of this Response. If any additional fees are due, or an overpayment has been made, please charge, or credit, our Deposit Account No. 11-0171 for such sum.

If the Examiner has any questions regarding the present application, the Examiner is cordially invited to contact Applicants' attorney at the telephone number provided below.

Respectfully submitted,



William D. Schmidt, Esq.
Registration No.: 39,492
Attorney for Applicant

Kalow & Springut LLP
Telephone No.: (212) 813-1600